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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,559	03/02/2001	Reinhard Plaschka	JEK/PILASCHKA	3460

7590

09/17/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/719,559

Applicant(s)

PLASCHKA ET AL.

Examin r

Lawrence D Ferguson

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-- The MAILING DATE f this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-19 and 21-45 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed June 27, 2003.
- Claims 18,20,29 and 30 were amended and new claims 38-45 were added rendering claims 18-37 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 18-19, 21-28, 35 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al (U.S. 5,161,829) in view of Martin (U.S. 5,601,683).
4. Detrick discloses a security paper (column 2, lines 14-18) comprising a coating of adhesive material (126) over a layer of paper (110) (column 9, lines 55-59) as shown in Figure 3. The adhesive layer lacks polyurethane and a filler substance. Detrick discloses the security paper enabling an indicia to be detectable in transmitted light and imperceptible on a photocopy made by utilizing reflected light (column 10, lines 28-46) where the security paper is made of cotton fibers and other known natural and synthetic fibers (column 3, lines 55-59). In claims 18 and 38, the phrase, 'a paper layer useful for

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producing documents of value' is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, in instant claim 38, the phrase, 'forming a surface dirt repellant film on the fibers of the paper' is directed to a product by process claim limitation, which is given little patentable weight in product claims. Although Detrick does not explicitly disclose a dirt repellant surface, because the adhesive coating is positioned over a layer of paper (110) in Figure 3 and is on the interior of the security paper, the coating keeps dirt from forming on paper (110). Detrick does not explicitly disclose a coating weight. The coating weight is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the adhesive layer because discovering the optimum or workable range involves only routine skill in the art. The coating weight directly affects the durability of the security paper. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Detrick does not disclose a substance having at least one visually or machine detectable property in the coating. Martin teaches a security document comprising a coating mixture containing a printing means that is machine detectable (column 3, lines 37-60). Detrick and Martin are analogous art because they are from the same field of security documents. It would have been obvious to one of ordinary skill in the art to

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include a machine detectable property in the coating of Detrick because Martin teaches having this feature in the coating hinders the security document from being photocopied.

Claim Rejections – 35 USC § 103(a)

5. Claim 29-34 and 36-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (U.S. 5,817,205).

6. Kaule teaches making a security paper (column 3, lines 44-45 and column 6, lines 13-36) by applying a coat to the paper surface (column 5, lines 1-3) along with lacquers and printed protective layers (column 5, lines 59-65). Kaule teaches the paper comprising paper fibers (column 7, line 67) where the surface is suitable for producing isolated coated areas (column 8, lines 29-31). The reference discloses a paper machine cutting the paper to a desired size (column 9, lines 11-24). The coating of Kaule lacks both polyurethane and a filler substance. In claims 29, 30 and 38, the phrase, 'surface coating for improving durability of the paper layer' is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458,

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459 (CCPA 1963). Additionally, in instant claim 38, the phrase, 'forming a surface dirt repellant film on the fibers of the paper' is directed to a product by process claim limitation, which is given little patentable weight in product claims. Although Kaule does not explicitly disclose a dirt repellant surface, it would have been obvious to one of ordinary skill in the art that the coating of Kaule repels dirt because the coating is provided with lacquers and printed protective layers (column 5, lines 59-65) which helps keep the security paper free from dirt.

7. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Arguments made in regards to rejection made under 35 USC 112, second paragraph have overcome the rejection due to amendment of claim 20.

Rejection made under 35 U.S.C. 102(b) as being anticipated by Detrick et al (U.S. 5,161,829) has been withdrawn due to amendments made by Applicant to claim

18. Rejection made under 35 U.S.C. 102(b) as being anticipated by Kaule (U.S.

5,817,205) has been withdrawn due to amendments made by Applicant to claim 29.

Arguments made in regards to rejection made under 35 USC 103(a) as being

unpatentable over Detrick et al (U.S. 5,161,829) in view of Martin (U.S. 5,601,683) has

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been considered but is unpersuasive. Applicant argues Detrick fails to disclose or suggest a surface coating for a security paper that is dirt repellant, as recited in amended claim 18. Examiner is not persuaded by this argument because although Detrick does not explicitly disclose a dirt repellant surface, because the adhesive coating is positioned over a layer of paper (110) in Figure 3 and is on the interior of the security paper, the coating keeps dirt from forming on paper (110). Applicant further argues the adhesive layer cannot reasonably be construed to disclose a surface coating that is 'dirt repellant' because an adhesive cannot function as an adhesive and dirt repellant. Examiner respectfully disagrees because the adhesive coating is positioned over a layer of paper (110) in Figure 3 and is on the interior of the security paper, the coating keeps dirt from forming on paper (110). Furthermore, Applicant lacks support for this presumption. Because Detrick has been maintained, Martin is maintained for reasons of record.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1:136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

